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EXAMINER

GILLESPIE, BENJAMIN

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1796

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Note

Continuation of Section 11:

1. Applicants remarks filed 3/14/2008 with respect to the rejection of
 - a. Claim 13 under 35 U.S.C. 112 2nd paragraph,
 - b. Claims 1, 3-8, 11, 12, and 1-16 under 35 U.S.C. 103(a) as being unpatentable over Lokai et al ('983) in view of Neuhaus et al ('604), and
 - c. Claims 1, 3-8, and 11-16 under 35 U.S.C. 103(a) as being unpatentable over Lokai et al ('983) in view of Neuhaus et al ('604), and in further view of Paulus et al ('991),Have been review but are not persuasive.
2. Firstly, applicants argue that the language of claim 13 does not raise any issues of indefiniteness based on the explanation given in the response filed 3/14/2008. However the examiner would like to point out that applicants' explanation does not reflect the claim; the language of claim 13 that defines the amounts of each alkoxyated polyol, i.e. fully, partially, and unesterfied polyol are based on "the fluid medium," but this term lacks antecedent basis and as a result it is not definitively clear what it constitutes.
3. Secondly, applicants argue the claimed invention is patentable over the prior art because one of ordinary skill would not have been motivated to combine the teachings of Lokai et al with Neuhaus et al because each arrive at the polyether polyol acrylate intermediate through different methods, and even upon including the hydroxyalkyl(meth)acrylate of Neuhaus et al, one would not have been motivated to arrive at methodology of claim 1, specifically step "1)".
4. The examiner notes that Neuhaus et al is silent with respect to the epoxy compounds, however the determination that a reference is from a nonanalogous art is twofold. First it is

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decided if the reference is within the field of the inventor's endeavor, and if it is not then it must be determined whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood*, 202 USPQ 171, 174; *In re Clay*, 23 USPQ.2d 1058.

Both Lokai et al and Neuhaus et al are drawn to radiation curable compounds based on the reaction product of alkoxyolated trimethylol propane and polyisocyanate, and the teachings of Neuhaus et al are particularly important because it shows how to reduce unwanted reactive diluents, which Lokai et al rely upon and is further demonstrated below:

Lokai et al:

[(Ai) OH-functional alkoxyolated polyol polyacrylates + (B) polyisocyanate], in the presence of (Ci) diacrylate

Neuhaus et al:

(Aii) OH-functional alkoxyolated polyol polyacrylates + (B) polyisocyanate + (Cii) hydroxyl-alkyl(meth)acrylate,

5. Again, while the examiner notes the prior art differs in how (Ai) and (Aii) are obtained, both compounds result in acrylate-functional polyether polyol that preferably have low residual acid content prior to their reaction with polyisocyanate (Neuhaus et al; col 7 lines 66-68). Similarly, while the examiner agrees that (Ci) and (Cii) are different compounds, it is important to note that if Lokai et al disclosed hydroxyl-alkyl(meth)acrylates there would be no need for a 103(a) combination rejection with Neuhaus et al. Instead, Neuhaus et al explain how the inclusion of (Cii) allows for the omission of (Ci), which is desirable since (Ci) causes unwanted odor and poor performance in the final coating. Finally, regarding applicants remarks concerning the claimed "I" step, Neuhaus et al in example 2 show that the acrylate-functional

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polyether polyol is synthesized first, then reacted with polyisocyanate + (Cii)
hydroxylalkyl(meth)acrylate.

6. Therefore, in view of the response present above the examiner maintains the position that it would have been obvious to combine the teachings of the prior art, thereby arriving at applicants' claimed invention.

/Rabon Sergent/

Primary Examiner, Art Unit 1796